

Goldschmitt's invention relates to a method for providing free email messaging to end-users, wherein the free email messaging is supported by sponsors who advertise their products and services by appending an advertisement to an email message after a special delimiter. In the operation of an aspect of Goldschmitt's invention, an email message sent by a sender is received and stored at a remote mail server associated with advertisement sponsors. Upon request by an addressee to download a message, an advertisement is selected and appended to the email message after a special delimiter, then the email and the appended advertisement is sent to the addressee (see page 3, lines 18-28 of Goldschmitt). The method of delivery of an advertisement in the system for providing free email service of Goldschmitt is specifically designed for providing, among other things, specific advertisement at specific targeted time of the day. Therefore, an advertisement is appended to an incoming email as the email is downloaded by the addressee from the email server (see page 4, line 26 to page 5, line 19 of Goldschmitt).

Applicant further notes that the Examiner has provided an inconsistent analysis of the limitation "associating a preselected advertisement with said communication within the data processing system with the sending party." In one instance (Office Action, page 3, item 4), the Examiner contends that Goldschmitt discloses this limitation; whereas, in another instance, it is admitted that this feature is not explicitly disclosed in Goldschmitt. (Office Action, page 4, lines 4-6). In addition to being deficient in disclosing or suggesting initiating a communication from a user-managed data processing system associated with the sending party, Goldschmitt, as the Examiner recognizes, is also deficient in the steps of associating a preselected advertisement with a communication within the user-managed data processing system associated with the sending party and transmitting said communication with said preselected advertisement embedded therein to the recipient, as set forth in independent claim 1.

According to Goldschmitt, messages are sent by user 12 to user 20 and is stored at center 18 until user 20 accesses it. (Goldschmitt Fig. 1, page 8, line 26 - page 9, line 2) When user 20 commands to read the message, the center 18 then appends an advertisement, if any, to the message and transmits the message to user 20. Thus, subscribers of the free email messaging of Goldschmitt have no control over the products, or services that are advertised by the sponsors,

such that spamming would be considered as an effect of utilizing Goldschmitt's invention. According to Goldschmitt, subscribers of free email are provided with no choice but to have email advertisement appended to their messages. Moreover, the center 20 and email server 18 of Goldschmitt are not managed by the user or email sender. That is, the sending party does not have control or management of Goldschmitt center 20 and email server 18 to perform the steps recited in Applicant's pending claims.

Accordingly, with respect to claim 1, Applicant respectfully submits that Goldschmitt does not teach, disclose or suggest the claimed steps of associating a preselected advertisement within the user-managed data processing system, as claimed.

The Examiner further contends that Kamakura discloses the claimed limitation of "associating the preselected advertisement with said communication within the user-managed data processing system." Kamakura is directed to an information providing apparatus for automatically determining the distribution of information received by a receiver from a sender. Unlike the present invention, Kamakura does not teach associating one piece of information (i.e. advertisement) with another piece of information (e.g., e-mail communication) for transmission to an identified recipient. To the contrary, Kamakura discloses associating (i.e. bringing together) a recipient that has requested to receive information (i.e. advertisements) of a certain type with a sender (e.g., commodities merchant) that desires to find recipients that want and are willing to receive their information. In other words, Kamakura discloses an information providing apparatus for performing a process for distributing nonspecific information from a sender to a receiver. The information reception requirements includes specific attributes of a receiver and the desired type of the information to be transmitted. Thus, the information reception requirement is designated, not by the sender, but by the receiver. When the information attributes satisfy (i.e., match) the desired conditions for the receivers, the distribution of the information from the sender to the receivers is allowed (See Col. 1, lines 50-54, 60-67, Col. 2, lines 3-7).

Accordingly, Kamakura also does not associate preselected advertisements within the user-managed data processing system, as claimed. Rather, in Kamakura, the information to be communicated is associated outside of the user managed data system (i.e., Sender Terminal).

With respect to claims 2, 3, 4, 5, 6, 9, 15, 16, 18, and 19, Applicant's argument in relation to independent claim 1 is also applicable to the rejection of dependent claims 4, 5, 6, 9, 15, 16, 18, and 19.

With respect to claim 2, the Examiner contends that by offering free email Goldschmitt provides a sender an option to become an advertiser. However, it is respectfully submitted that Goldschmitt offers free email messaging with no opportunity for a user of free email messaging to select whether he/she can opt out of having advertisements appended to his/her email messages. To the contrary, in accordance with the present invention, if the offering to become an advertiser is not accepted, no advertisement would be associated with an email, as recited in claim 2. Therefore, if a sender chooses not to become an advertiser, he/she can still send an email. Furthermore, in the presently claimed invention, the sender manages the data processing system, as well as the advertisement option. Thus, the sending party is empowered with the choice relating to the type of advertisement as well as the intended recipients so that a grass-root effect can be achieved and so that spamming can be avoided. This cannot be accomplished in the invention disclosed in Goldschmitt.

With respect to claims 8, 10-13, and 17, Applicant's argument in relation to dependent claim 2 is also applicable to the rejection of dependent claims 8, 10-13, and 17.

With respect to claim 3, it is respectfully submitted that Goldschmitt does not teach or suggest the feature wherein the advertisement is associated with at least one of software or hardware operable with the user-managed data processing system. The abstract of the Goldschmitt reference merely states that information related to a particular subscriber communication network, which is a part of the email server communication network associated with the sponsors, could be shown in an advertisement. However, there is no suggestion of the software or hardware operable with the user-managed data processing system associated with the sending party as recited in claim 3.

In view of the foregoing, it is respectfully submitted that Goldschmitt, The Mail, and Kamakura, taken alone or in combination, fail to teach each and every element of claims 1-19, as required for a prima facie case of obviousness under § 103. Accordingly, the Examiner's withdrawal of these rejection is requested.

With respect to independent claim 20, the Examiner concedes that Goldschmitt does not disclose locating a data file containing signature information on the user-managed data processing system associated with the sending party, the signature information being appended to electronic communications originating from the user-managed data processing system associated with the sending party, modifying information stored within the signature file to include an advertisement, and transmitting an electronic communication using the user-managed data processing system associated with the sending party to the data processing system associated with a recipient, wherein the electronic communication includes the information stored within the signature file and the advertisement.

Applicant appreciates the Examiner's acknowledgment of the deficiencies of Goldschmitt and respectfully submits that Goldschmitt specifically teaches that advertisements are appended to an email message after a special delimitator, and a delimiter is positioned between an email message and an advertisement. Further, Applicant respectfully submits that Goldschmitt does not teach, disclose, or suggest modifying the information stored in the signature file to include an advertisement.

It is acknowledged that signature block is well known and incorporating hypertext links and graphics is also well known. However, Applicant respectfully submit that modifying the signature block so as to include advertisement information is not known, as shown by the lack of disclosure or suggestion of such a feature in the cited prior art references.

Further, Applicant respectfully submits that graphics and hypertext links found in signature blocks are customarily added to a signature block one time during the creation of a signature block, and that the signature block is customarily not modified as an email message is being processed for transmission. Moreover, it would not be possible for the remotely located message center 18, wherein the appending of an advertisement to an email message is performed, to have access to the sending party's signature file to modify it in the manner recited in claim 20.

Applicant respectfully submit that the Examiner's contention that it is obvious to modify the signature block to include advertisement information based on the known existence of hypertext links and graphics in a signature block is purely a hind sight and is insupportable.

With respect to claim 21, as discussed above, the signature file is associated with a email client operating on the user-managed data processing system associated with the sending party. Therefore, it would not be possible for the free email system of Goldschmitt to have access and to manipulate the information in the signature file stored in the user-managed data processing system of the sending party as contended by the Examiner.

With respect to the rejection of claim 22, Applicant's arguments set forth above with respect to claim 1 also are applicable to dependent claim 22, as Uomini is also deficient in disclosing, teaching, or suggesting initiating a communication from a user-managed data processing system associated with the sending party, associating a preselected advertisement with a communication within the user-managed data processing system associated with the sending party and transmitting said communication with said preselected advertisement embedded therein to the recipient as set forth in amended independent claim 1.

Contrary to the Examiner's suggestion, Goldschmitt, Kamakura, and Uomini, either taken alone or in combination, do not disclose each and every element of claims 20-22, as required for a prima facie case of obviousness under § 103. Accordingly, the Examiner's withdrawal of the rejections of claims 20-22 is respectfully requested.

### **CONCLUSION**


Having responded to all rejections set forth in the outstanding Office Action, it is submitted that claims 1-22 are now in condition for allowance. An early and favorable Notice of Allowance is respectfully solicited.

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In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, the Examiner is courteously requested to contact Applicants' undersigned representative.

Respectfully submitted,

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